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EXAMINER

CAMPEN, KELLY SCAGGS

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3691

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

The following is in response to the amendments and arguments filed 10/20/2008.

Claims 1-7 and 10-11 are pending.

Priority

Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Taiwan on April 11, 2003. It is noted, however, that applicant has not filed a certified copy of the 92108302 application as required by 35 U.S.C. 119(b).

Information Disclosure Statement

The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper."

Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Specification

The abstract of the disclosure is objected to because it includes language which may be implied ("A system **includes**..."see below, emphasis added). Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

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The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6-7, 10-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically as to claim 6, it is unclear how the winning supplier is selected in the granting step of the claim.

Claims 7, 10-11 depend from claim 6 and are thus indefinite for the above reason.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

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Claims 6-7, 10-11 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 6-7, 10-11 recite a process comprising the steps of receiving, accessing, opening, comparing, and granting. Based on Supreme Court precedent, a proper process must be tied to another statutory class or transform underlying subject matter to a different state or thing (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876)). Since neither of these requirements is met by the claim, the method is not considered a patent eligible process under 35 U.S.C. 101. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Storing the bid record in the database is a nominal tie to a statutory class.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-7 and 10-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Giovannoli (US 5758328) in view of Aycock et al. (US 5765138).

Specifically as to claims 1 and 6, Giovannoli discloses a system and the related method for purchasing products through bidding online, the system comprising a corporation website, an application server, a database linking to the application server through a connection, a plurality of client computers linking to the corporation website through a network, and a plurality of supplier computers linking to the corporation website through an external network (figure 1), wherein the application server comprises: a supplier data management module for maintaining basic information on suppliers and their products, and for selecting a plurality of suitable suppliers according to information on products to be purchased; a price inquiring/quoting/price negotiating management module for inquiring of prices, receiving quotations from the selected suppliers, negotiating prices, and generating price-related records; an online bidding management module for opening a bid, comparing bidding results according to price-related records,

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determining a winning supplier, granting a winning bid to the winning supplier, and generating bid-related records but does not specifically disclose a contract management module for signing procurement contracts with winning suppliers online, and for maintaining the procurement contracts.

Aycock et al disclose a method for providing interactive evaluation of potential vendors with contract procurement maintenance and signing (see figure 6).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include in the financial system of Giovannoli the ability to provide interactive evaluation of potential vendors with contract procurement maintenance and signing as taught by Aycock et al. since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Specifically as to claim 2, wherein the application server further comprises a procurement data management module for maintaining information on products to be purchased for a purchasing organization (see figures 7 and 8).

Specifically as to claim 3, a stock receiving and accounts balancing module for receiving and checking of products delivered by a winning supplier according to information on products to be purchased (see figures 8 and 7).

Specifically as to claim 4, a price inquiring sub-module for inquiring of prices of selected suppliers, and generating price inquiring records; a quotation receiving sub-module for receiving quotations provided by inquired suppliers, and generating quoting records; a price negotiating sub-module for negotiating prices with suppliers, and

generating price negotiating records; and
a price-related record maintaining sub-module for adding, deleting and checking price-related records, said price-related records comprising price inquiring records, quoting records and price negotiating records (col. 7-8).

Specifically as to claim 5, the online bidding management module comprises: a bid opening sub-module for opening a bid for selected suppliers logging on the corporation website to bid online, and generating a bid opening record; a bid comparing sub-module for selecting a winning supplier according to quoting records, price negotiating records and information on products to be purchased, and for generating a bid comparing record; a bid granting sub-module for granting a winning bid to a winning supplier, and generating a bid granting record; and a bidding record maintaining sub-module for adding, deleting, modifying and searching bid-related records, said bid-related records comprising bid opening records, bid comparing records and bid granting records (see figure 4 and 5-6).

Specifically as to claim 7, signing a procurement contract with the winning supplier; and checking the products delivered by the winning supplier according to the information on the products to be purchased (see fig. 1 and 6).

Specifically as to claim 10, comparing the other selected suppliers and selecting a new winning supplier on the condition that the winning supplier does not accept the grant (figures 4-6).

Specifically as to claim 11, the step of notifying the winning supplier that the products must be re-delivered or that the products will be returned (see figure 4-6).

Examiner's Note

Examiner has cited particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Response to Arguments

Applicant's arguments filed 10/20/2008 have been fully considered but they are not persuasive.

With regards to applicants' argument that Giovannoli and Aycock et al. do not teach a price inquiry...an online bidding management..." Examiner disagrees. Applicant appears to be relying on intended use of the system. The claim must distinguish in terms of structure not function. Recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. In addition, the system in of Giovannoli and Aycock et al. is capable of performing the function of the server in claim 1.

In response to applicant's argument that Giovannoli and Aycock et al. do not teach a module for signing procurement contract with winning suppliers online and for maintaining the procurement contracts, a recitation of the intended use of the claimed

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invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In addition, applicant argues that an operating system that responds to requests is different than the feature of signing procurement online as the signing may be the request made of the system, it is capable of performing that function.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With regards to applicants' argument to the 35 USC 101 rejection, Examiner disagrees. To qualify as a statutory process, the claim should positively recite the other statutory class to which it is tied, for example by identifying the apparatus that accomplished the method steps or positively reciting the subject matter that is being transformed, for example by identifying the material that is being changed to a different state. Storing the bid record in the database is a nominal tie to a statutory class.

Applicants' amendments and arguments have overcome the Objection to the Specification for the Abstract, as such, the Objection to the Specification has been withdrawn.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KELLY CAMPEN whose telephone number is (571)272-6740. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kelly Campen/
Primary Examiner, Art Unit 3691